

1745

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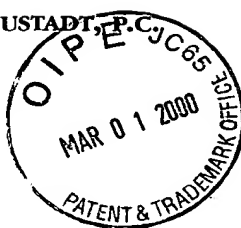
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PATENT, TRADEMARK AND COPYRIGHT LAW
AND RELATED FEDERAL AND ITC LITIGATION



DOCKET NO.: 0050-1545-0

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Re: Serial No.: 09/160,583
Applicant: Takako KAMO
Filing Date: September 25, 1998
For: NONAQUEOUS SECONDARY BATTERY
GAU: 1745
Examiner: J. CREPEAU

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

Our check in the amount of \$-0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. §1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. §1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO.: 0050-1545-0

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
Takako KAMO : GROUP ART UNIT: 1745
SERIAL NO.: 09/160,583 :
FILED: September 25, 1998 : EXAMINER: J. CREPEAU
FOR: NONAQUEOUS SECONDARY BATTERY



RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the Official Action mailed January 31, 2000, the Applicant elects, with traverse, Group I, Claims 1-19. In addition, as a single disclosed species the Applicant provisionally elects, for search purposes only, the species A_aS. Claims 1-5 and 19 are readable on the elected species.

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REMARKS

Claims 1-20 remain active in this application. The Restriction and Election Requirement is respectfully traversed for the following reasons.

The Office is requiring restriction to one of the following Groups:

Group I: Claims 1-19, drawn to a secondary battery or negative electrode; and

Group II: Claim 20, drawn to an electrode material of a capacitor.

The Applicant has elected, with traverse, Group I, Claims 1-19. In addition, the Office is requiring an election of a single disclosed species as listed in paragraph (4) of the

Official Action. The Applicant has provisionally elected, for search purposes, the species identified as A_aS. It is believed that Claims 1-5 and 19 are readable on the elected species.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct and there is a serious burden on the Office if restriction is not required (MPEP §803). The Applicant traverses the Restriction Requirement on the grounds that no adequate reasons or examples have been provided to support a conclusion of patentable distinctness between the restricted groups or to show that a serious burden would be placed on the Office if restriction is not required.

The Office has characterized the inventions of Groups I and II as unrelated. The Examiner has concluded that the respective inventions are not disclosed as capable of use together and that they have different modes of operation and different functions, citing MPEP §806.04 and §808.01.

The Applicant respectfully traverses the Restriction Requirement on the ground that the Office has not sustained the burden of providing an adequate reason why the respective inventions are independent. The Applicant respectfully submits that merely describing the inventions of Groups I and II as independent does not represent proof to support the conclusion that the respective inventions have different modes of operation and functions. The Examiner's attention is directed to MPEP §808.01, which states that situations involving independent inventions are rarely presented and that Form Paragraph 8.20.20 should only be used when the claims presented are to "totally unrelated inventive concepts". The Applicant submits that the Office has not shown that the claims are directed to totally unrelated inventive concepts.

With respect to the Election of Species Requirement, the Office has not provided any reason to support a conclusion of patentable distinctness between the species. The Office has

merely stated that claims are directed to a plurality of patentably distinct species.

Accordingly, the Applicant's election is for search purposes only.

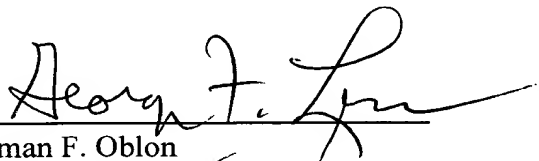
The Applicant notes that with the provisional election of species, should no prior art be found that anticipates or renders obvious the elected species, then the search of the claims should be extended. MPEP §803.02. The Applicant also notes that the Office should not require restriction to a reasonable number of species unless it would be willing to allow claims to each of the claimed species over the parent case. MPEP §806.04(h).

The Applicant respectfully traverses the Restriction Requirement on the grounds that the Office has not shown how a search of only two subclasses would be burdensome. The Applicant respectfully points out that thousands of U.S. Patents have issued in which many more than two subclasses have been searched, and the Office cannot reasonably posit that a search of only two subclasses would be burdensome. Accordingly, the restriction is believed to be improper, and its withdrawal is respectfully requested.

The Applicant respectfully submits that the above-identified application is now in condition for examination on the merits. An early notice to that effect is earnestly solicited.

Respectfully submitted,

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